

**REMARKS**

In the final Office Action dated July 28, 2008, the Examiner rejected pending claims 1-18 and 20-30. More specifically:

- Claims 1-4, 6-10, 12-18, 20-24 and 26-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,356,864 (Foltz) in view of U.S. Published Application No. 2004/0002994 (Brill) and U.S. Published Application No. 2004/0093567 (Schabes)

- Claims 5, 11 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Foltz in view of Brill and Schabes as applied to claims 1 and 16, and further in view of U.S. Published Application No. 2003/0149692 (Mitchell)

Applicants respectfully submit that none of the prior art cited by the Examiner discloses, teaches or suggests all the elements of the claims, as amended. Therefore, neither independent claim 1 nor 16, as amended, is obvious based upon any of the cited art. Because claim 1 and 16 are patentable, their dependent claims are patentable as dependent from patentable base claims. See MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Reconsideration of those claims is also respectfully requested. Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103 rejections.

Applicants note that Mitchell extracts nouns, verbs, modifiers, prepositions, adjectives, and adverbs for example, and then submits data representations of such constituent parts of each student answer to semantic analysis. See for example paragraphs [0026] and [0048]-[0054] of Mitchell. Mitchell not only fails to teach or suggest but actually teaches away from **not considering** the function words of the essay, as taught and claimed in the present invention. In paragraph [0031] of the published version of the present patent application (U.S. Patent Application Publication 2004/0194036), corresponding to paragraph [0030] on page 9 of the as-filed application, the inventors state “Prior to generating the vector files, function words such as prepositions, articles, and auxiliary verbs, may be **removed**. For example, the function words (the, that, what, a, an, and, not) have been empirically found to increase the complexity of the analysis without contributing to the reliability of the result.” (emphasis added). The Examiner’s assertion that in Mitchell “certain words of the essay are not considered by the assessment tool since they are altered to the reduced variant form” is not entirely correct; such words are converted to the reduced variant form specifically so they **can** indeed be considered by Mitchell,

in contrast to the claimed embodiments of the present invention which intentionally do **not** consider them. Applicants amend the independent claims in this response to clarify that functional words are excluded from consideration by embodiments of the present invention, to distinguish such exclusion from merely altering words to a root form that then is considered.


Regarding dependent claims 11 and 25, Applicants assert that Mitchell does not process pronouns (vs. general nouns, which are distinct from pronouns) at all, as taught and claimed by the present invention. Applicants cite for example paragraph [0015] of Mitchell in toto: "Preferably, the natural language processing parses the mark scheme answer into constituent parts such as nouns, verbs, adjectives, adverbs, modifiers and propositions." and note that not only this paragraph but all of Mitchell fails to mention pronouns.

### CONCLUSION

In view of the remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of all pending claims. Applicants respectfully submit that the above amendments have not added any new matter to the application.

The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 05-0426. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to the Deposit Account.

Respectfully submitted,

  
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